REMARKS

In the May 30, 2003 Office Action, the Examiner noted that claims 1-19 were pending in the application; rejected claims 11-13 under 35 U.S.C. § 101; and rejected claims 1-19 under 35 U.S.C. § 103(a). In rejecting the claims, U.S. Patents 6,332,126 to Peirce et al. and 5,918,215 to Yoshioka et al. (References A and B, respectively) were cited. Claims 1-19 remain in the case. The Examiner's rejections are traversed below.

The Invention

The present invention is directed to determining membership qualification for a plurality of services by a user who already subscribes to one of the services, i.e., is a member of one of the services. In response to a request from a user, the system displays available service(s) for which the user meets the membership condition(s), or simulates such requests to generate a list of users that meet membership condition(s) for service(s) to which they do not subscribe. Thus it is possible to determine the number of users who are eligible for unused service(s).

The Prior Art

U.S. Patent 6,332,126 to Peirce et al.

The Peirce et al. patent is directed to a system and method for a targeted payment system discount program which uses information from consumer payment system institutions to match qualified consumers to targeted merchant discount offers based on the purchase history of the consumers. The system is designed for use by many merchants and many issuers of credit cards to target a cardholder population. To participate, "merchants must satisfy the Merchant Qualification Criteria" (column 5, lines 47-48) and card holders are targeted based on characteristics defined by merchants or "Dealmakers" (e.g., column 6, line 5). The results of such targeting are reported to the dealmaker or merchant on a "Query Status Screen" (column 6, line 54). Issuers of credit cards control whether their card holders receive offers generated by merchants or dealmakers "by providing merchant exclusion and prioritization perimeters for each Card Group" (column 9, lines 17-19). The system may be used to notify a consumer of currently discounted goods that are similar or related to goods that the consumer has purchased in the past.

U.S. Patent 5,918,215 to Yoshioka et al. et al.

The Yoshioka et al. patent is directed to a sales accounting system that stores credit card numbers of consumers, so that the service charges for use of the credit cards can be charged properly.

Rejections under 35 U.S.C. § 101

On page 2 of the Office Action, claims 11-13 were rejected under 35 U.S.C. § 101 because the claimed method "does not recite a useful, concrete and tangible result" (page 2, line 8). Therefore, claims 11-13 have been amended to clarify or add the final step of "displaying ... on a screen" (e.g., claim 11, last two lines) information generated by the preceding steps. If these amendments are insufficient to overcome the § 101 rejection, the Examiner is respectfully requested to contact the undersigned to arrange an Examiner Interview prior to the next Office Action, so that appropriate language can be discussed.

Rejections under 35 U.S.C. § 103

On pages 3-6 of the Office Action, claims 1-19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peirce et al. in view of Yoshioka et al. Claim 1 has been amended to recite a system which receives "from a user a request to present an available membership service for the user" (claim 1, lines 4-5), as described at page 36, line 16 to page 37, line 1 of the application. Neither Peirce nor Yoshioka et al. teach or suggest a system that does anything in response to a request from a user. As described above, Peirce et al. is directed to a system for generating targeted advertisements to consumers based on their past purchase history. While "issuers" are given control over whether groups of cardholders receive offers, no suggestion has been found that the cardholders themselves have any control over whether offers are sent to them. Meanwhile, Yoshioka et al. merely describes accounting for services that are provided on a discounted basis.

Furthermore, claim 1 has always recited "comparing ... a current service of which the user has become a member with ... at least one service of which the user has not become a member ... and selecting an eligible service of which the user can become a member" (claim 1, lines 6-10). It is unclear whether this limitation was considered to be "nonfunctional descriptive material" (Office Action, page 4, line 3) or "the manner in which a claimed apparatus is intended to employed" (Office Action, page 4, line 9). Regardless, it is submitted that the language quoted from lines 6-10 of claim 1 is neither, but rather is the recitation of an operation performed according to the invention that is significantly different from what is taught by the prior art. Now

that the claims have been amended to add that the comparison is performed "in response to the request" (claim 1, line 9) received from the user for "an available membership service" (claim 1, lines 4-5), it should be clear that the present invention is not taught or suggested by the prior art.

For the above reasons, it is submitted that claim 1 patentably distinguishes over Peirce et al. in view of Yoshioka et al. Since claims 4, 8, 9, 11, 12, 14, 15, 17 and 18 recite similar limitations it is submitted that claims 4, 8, 9, 11, 12, 14, 15, 17 and 18 similarly distinguish over Peirce et al. in view of Yoshioka et al.

Claims 2 and 3 depend from claim 1 and claim 5 depends from claim 4 and therefore, claims 2, 3 and 5 patentably distinguish over Peirce et al. in view of Yoshioka et al. for the reasons discussed above with respect to claim 1. In addition, claim 2 has been amended to recite details of how the selecting device operates based on the description at page 38, lines 2-10 of the application. No suggestion has been found in either Peirce et al. or Yoshioka et al. of generating "a totaled membership condition" (claim 2, line 3) by performing "an AND operation" (claim 2, line 3) on at least two services of which a user is a member. Therefore, it is submitted that claim 2 and claim 3 which depends therefrom further patentably distinguish over Peirce et al. in view of Yoshioka et al.

In the Office Action, it was asserted that the recitation of obtaining certificate information from a user as recited in claims 3 and 5 are "found in the nonfunctional descriptive material" (page 4, last line) and therefore were ignored for purposes of distinguishing over the prior art. In support for this rejection, *In re Gulack* and *In re Lowry* were cited. However, *In re Gulack* refers to "printed matter [which] is not functionally related to the substrate" 703 F.2d 1381, 1385, 217 USPQ 401, 404. Since claims 3 and 5 recite how certificate information is used to obtain information about the services, it is submitted that claims 3 and 5 are like the claims of *In re Gulack* in which the CAFC held that "the digits of Gulack's invention are functionally related to the band", Ibid. Similarly, *In re Lowry* held that "the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO" *In re Lowry*, 32 USPQ2d 1031, 1035 and that "data structures are specific electrical or magnetic structural elements in a memory... [that] provide tangible benefits", Ibid. It is submitted that certificates inherently require a specific type of data structure that is distinctly different from and provide benefits over any data structure taught by Peirce et al. or Yoshioka et al. Therefore, *In re Gulack* and *In re Lowry* do not provide support for ignoring the limitations of claims 3 and 5 which further patentably distinguish over Peirce et al. in view of Yoshioka et al. for the reasons discussed above.

On pages 5 and 6 of the Office Action, it was asserted that the simulating device recited in claim 6 was disclosed in the Summary of the Invention section and detailed specification of Peirce et al. at column 6, lines 14-54 and column 8, line 43 to column 9, line 15. These portions of Peirce et al. have been reviewed, but no suggestion has been found of "adding information of users who are members of an existing service to ... [obtain] a number of users who can become members of another service" (claim 6, lines 6-9), let alone doing so "by counting a number of pieces of information contained in the member count table" (claim 6, lines 10-11). Since similar limitations are recited in claims 13, 16 and 19, it is submitted that claims 6, 13, 16 and 19 patentably distinguish over Peirce et al. in view of Yoshioka et al.

Claim 7 depends from claim 6 and therefore, claim 7 patentably distinguishes over Peirce et al. in view of Yoshioka et al. for the reasons discussed above with respect to claim 6. In addition, claim 7 recites counting "a number of the pieces of certificate information contained in the member count table" (claim 7, line 7). As discussed above with respect to claims 3 and 5, it is submitted that this limitation cannot be ignored and therefore, claim 7 further patentably distinguishes over Peirce et al. in view of Yoshioka et al. for the reasons discussed above with respect to claims 3 and 5.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-19 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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on September 2, 2003
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